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UNITED STATES PATENT AND TRADEMARK OFFICE

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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 December 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-29,31,33-59,61,63-89 and 91-99</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,3-29,31,33-59,61,63-89 and 91-99</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>12/21/06</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

Duplicate Claims, Warning

Applicants' arguments (Remarks 12/05/06, Page 23 Lines 13-17) with respect to the warning of the duplication of claims 30, 60 and 90 have been fully considered and are persuasive. The warning of the duplication has been withdrawn in view of the cancelation of these claims.

Claim Rejections - 35 USC § 112

Applicants' arguments (Remarks 12/05/06, Page 23 Line 13-Page 24 Line 5) with respect to the previous rejection of claims 1, 30, 31, 60, 61 and 90 under 35 U.S.C. § 112, first paragraph, have been fully considered and are persuasive. The rejection of claims 1, 30, 31, 60, 61 and 90 under 35 U.S.C. § 112, first paragraph, has been withdrawn in view of the cancelation of claims 30, 60 and 90 and the amendment of claims 1, 31 and 61.

Claim Rejections - 35 USC § 103

• The rejection of claims 30, 60 and 90 under 35 U.S.C. § 103 has been withdrawn in view of the cancelation of claims 30, 60 and 90.

• Applicants' arguments with respect to the rejection of claims 1, 6 - 8, 11-23, 25-28, 31, 36-38, 41-53, 55-58, 61, 66-68, 71-83, 85-88, 91, 94 and 97 have been fully considered but they are not persuasive.

As argued by applicants:

(1)   with respect to the rejection of claims 1, 31 and 61 (Remarks 12/05/06, Page 24

Line 11-Page 27 Line 18):

> ... independent claims 1, 31 and 61 have been amended and recite the features of: creating a content
> object, being one of a book, a document, a collection of images, a collection of musical selections, a
> video and a multimedia object, from a collection of content; the content object including a user
> defined hierarchical structure including at least one hierarchical tier and at least one subordinate tier;
> and in response to selection by a user of one or more of the objects and assignment by the user of the
> selected objects to corresponding ones of the at least one hierarchical tier and the at least one
> subordinate tier, creating a custom content object a hierarchical compilation of the content
> represented by each selected object in accordance with the assignment of the selected objects by the
> user. Dependent claims 3-5, 9, 12-19, 24, 26, 33 - 35, 39, 42-49, 54, 56, 63-65, 69, 72-79, 84, 86 and
> 91-99 have been amended for consistency with their amended parent claims.
> The McGraw-Hill publication does not disclose, teach or suggest these features...
> ...
>
> ... However, these just indicate the origin of the selected portions (e.g., the chapter and book from
> which the portion is selected) and do not provide a hierarchical arrangement for the new book...
>
> ... there is no disclosure, teaching or suggestion of the portions being arranged into hierarchical
> tiers or, for that matter, the portions being assigned by the user to corresponding hierarchical and
> subordinate tiers of the user defined content object structure to create the content object as recited in
> the claims.
>
> ... The Santamaki et al. patent does not compensate for the deficiencies of the McGraw-Hill
> publication and Warnock et al. patents. Rather, the Santamaki et al. patent is directed toward an
> electronic book system for advancing distribution of reading materials and is merely utilized by the
> Examiner for an alleged teaching of centralized and e-book servers allegedly corresponding to the
> claimed library and object servers.

(2)   with respect to the rejection of claims 6-8, 11- 3, 25-28, 36-38, 41-53, 55-58, 66-

68, 71-83, 85-88, 91, 94 and 97 (Remarks 12/05/06, Page 27 Line 19-Page 28 Line 2):

> Claims 6-8, 11- 3, 25-28, 36-38, 41-53, 55-58, 66-68, 71-83, 85-88, 91, 94 and 97 depend either
> directly or indirectly from independent claims 1, 31 or 61 and, therefore, include all the limitations of
> their parent claims. These claims are considered to be in condition for allowance for substantially the
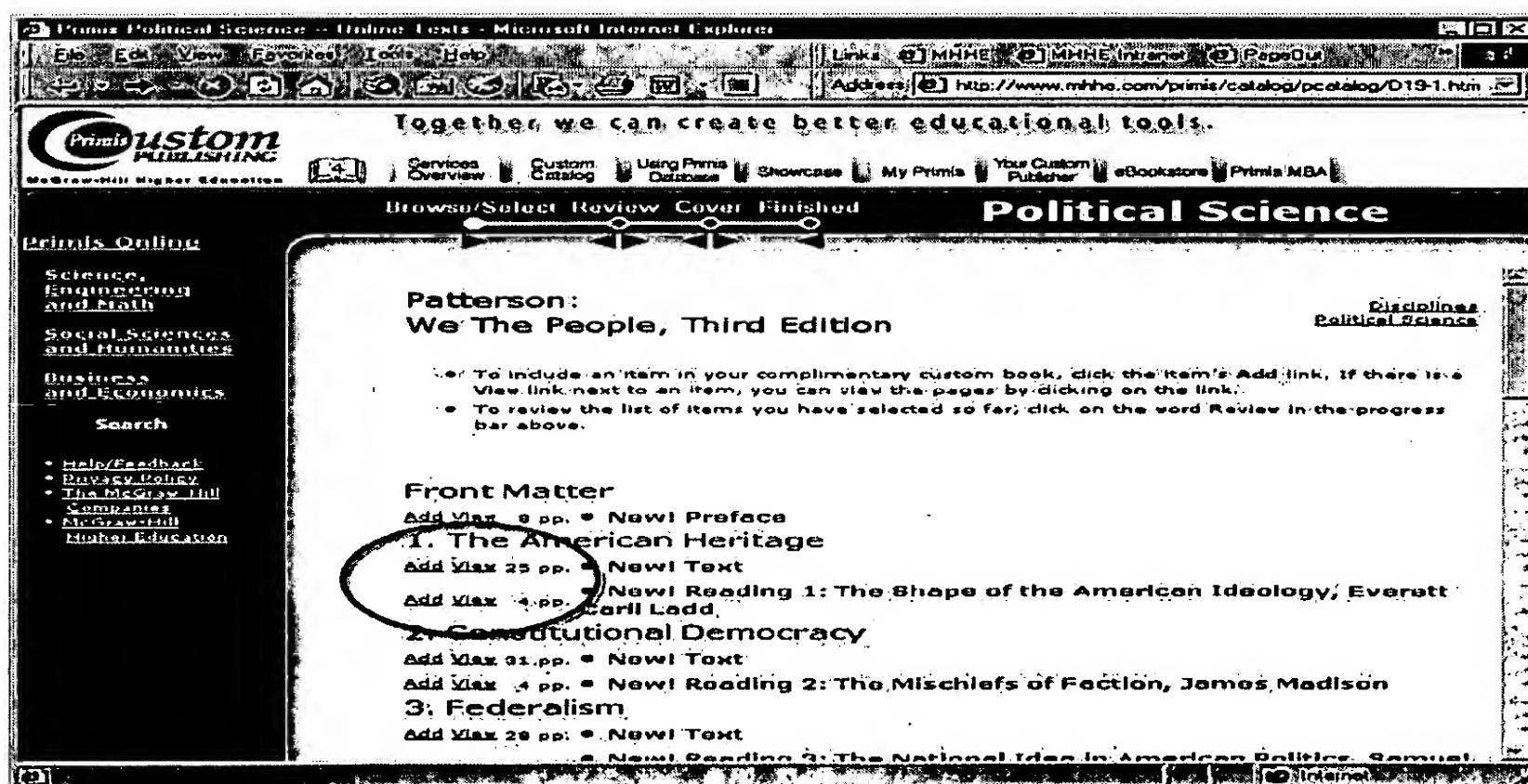
same reasons discussed above in relation to their parent claims and for further limitations recited in the claims.

Examiner respectfully disagrees.

(1)   McGraw-Hill teaches a method and system for creating a customized e-book (Page 3, "What is Primis Database Publishing") as *a content object being one of a book* from *a collection of content* as illustrated in Pages 5-10. Materials from the collection of content are added to the customized e-book via the GUI of Slide 1. The user can arrange the hierarchical structure of the customized e-book, e.g., Title, Chapters, Sections and Texts, via the GUI of Slide 2. This teaching indicates the claimed limitation *the content object*, e.g., customized e-book, *includes a user defined hierarchical structure*, e.g., Book Number, Chapters, Sections and Texts, *including at least on hierarchical tier*, e.g., Book Number, *and at least one subordinate tier*, e.g., Chapter;
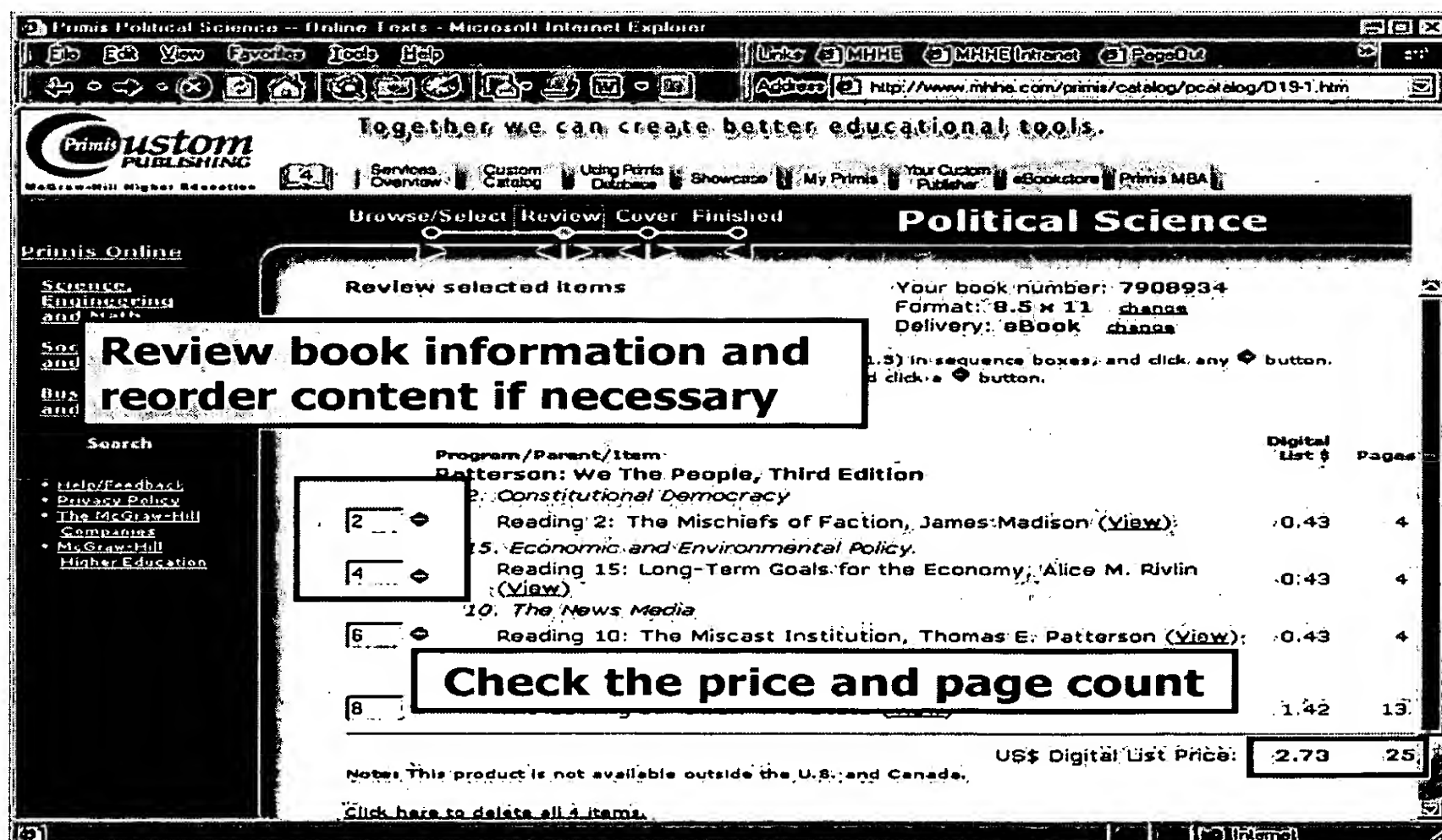
The GUI of Slide 1 also indicates the step of *presenting a plurality of selectable objects to a user*, e.g., "New! Text" and "New! Reading 1: The Shape of the American Ideology, Everett Carl Ladd", *each object representing a subset of the collection of content* as in Pages 5-10;
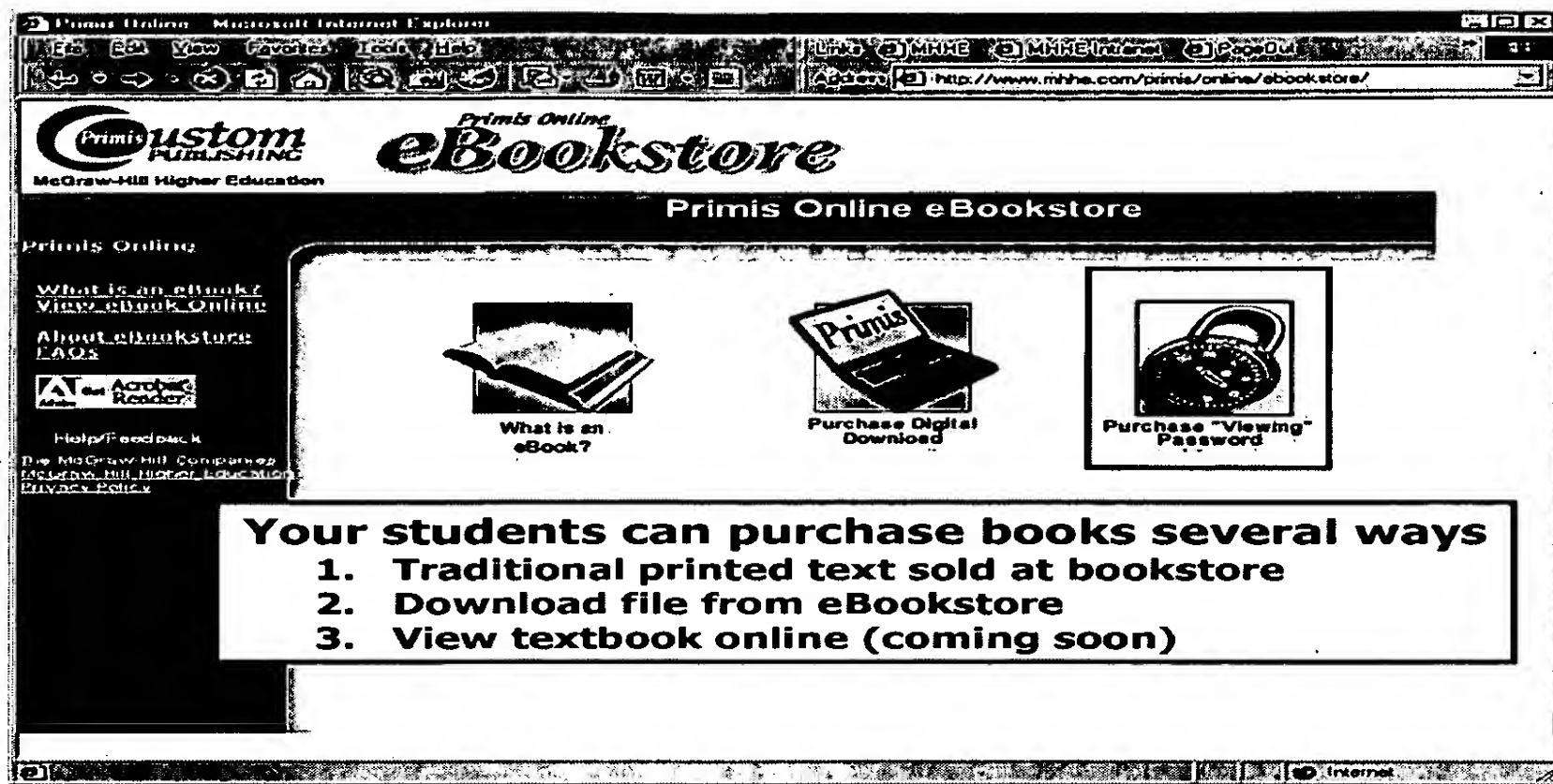

Slide 1

in response to selection by a user of one or more of chapters and sections as *objects* by using the

add button via the GUI of Slide 1, and *assignment by said user of said selected objects to corresponding*

ones of said at least one hierarchical tier and said at least one subordinate tier via the GUI of Slide 2, e.g.,

the selected object "Reading 2: The Mischiefs of Faction, James Madison" is assigned under a

Book Number 7908934 and a Chapter "Patterson: We The People". The customized e-book that

has book number 7908934 as *a custom content object* is created. The created customized e-book

includes a hierarchical compilation of the content represented by each selected object, Chapter "Patterson: We

The People" and Section "Constitutional Democracy". The Chapter "Patterson: We The People"

and Section "Constitutional Democracy" as *hierarchical compilation of the content* are *represented by*

each selected object, e.g., via the GUI of Slide 1, object "Reading 2: The Mischiefs of Faction,

James Madison" is selected, *in accordance with said assignment of said selected objects by said user*, e.g.,

the Chapters and Section is in accordance with the assignment of the selecting of "Reading 2:

The Mischiefs of Faction, James Madison" to the Book Number 7908934 via the GUI of Slide 2.

Slide 2

Slide 3

As further discloses by McGraw Hill, after creating the customized e-book, the e-book could be downloaded from eBookstore (Slide 3). This technique implies the customized e-book as *the custom content object* is *stored in* eBookstore as *one or more object servers*.

As show in the screen shot above, the created e-book includes *information specifying the custom content object*, e.g., Page Count, and *attribute information concerning the custom content object*, e.g., Price.

The missing of McGraw Hill is a *library server* for storing the information and attribute of the e-book.

As disclosed by Santamaki at Col. 5, Lines 6-16, a centralized server for storing the electronic written materials, and an e-book server for storing selected electronic written materials that have been converted into an electronic book format to subsequent download to a terminal for viewing.

Thus, the Santamaki teaching of centralized server as *library server*, obviously, could be used for storing *information specifying the custom content object*, e.g., Page Count, and *attribute information concerning the custom content object*, e.g., Price.

By using centralized server as *library server* for storing information and attributes, these

particular features of an e-book could be keep tracked and retrieved in accordance with the user

that creates the e-book.

(2)   Claims 6-8, 11- 3, 25-28, 36-38, 41-53, 55-58, 66-68, 71-83, 85-88, 91, 94 and

97 depend either directly or indirectly from independent claims 1, 31 or 61. These claims are

considered to be unpatentable for substantially the same reasons discussed above in relation to

their parent claims.

In light of the foregoing arguments, the 35 U.S.C. § 103 is hereby sustained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 30, 31, 60, 61 and 90 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the written description requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention.

As in claims 1, 31, 61, the claim limitation *in response to selection by a user of one or more of*

said objects and assignment by said user of said selected objects to corresponding ones of said at least one

hierarchical tier and said at least one subordinate tier, creating a custom content object including a hierarchical

compilation of the content represented by each selected object in accordance with said assignment of said selected

objects by said user was not described in the specification[1].

---

[1] As recited in claims 1, 31 and 61, *a content object* in the preamble, and *a custom content object* in response to selection by a user are two different entities. Nowhere in the specification illustrates the creation of *custom content object* is *in response to... assignment by said user of said selected objects to corresponding ones of said at least one hierarchical tier and said at least one subordinate tier* of *content object* and *in accordance with said assignment of said selected objects by said user*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 6-8, 11-23, 25-28, 31, 36-38, 41-53, 55-58, 61, 66-68, 71-83, 85-88, 91, 94

and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill

Companies [McGraw Hill Primis Custom Publishing] in view of Santamaki et al. [USP

6,886,036 B1].

Regarding claims 1, 31 and 61, McGraw-Hill teaches a method and system for creating

a customized e-book (Page 3, "What is Primis Database Publishing") as *a content object being one*

of a book from *a collection of content stored in a digital library having one or more object servers, wherein the*

content object includes a user defined hierarchical structure including at least one hierarchical tier and at least

one subordinate tier (*a collection of content* is illustrated in Pages 5-10. The *collection of content* is stored

at the McGraw Hill website as *a digital library*, the McGraw-Hill website has an eBookstore for

downloading file (Slide 3) as *one or more object servers*. Materials from the collection of content are

added to the customized e-book via the GUI of Slide 1. The user can arrange the hierarchical

structure of the customized e-book, e.g., Title, Chapters, Sections and Texts, via the GUI of

Slide 2. This teaching indicates the claimed limitation *the content object*, e.g., customized e-book,

includes a user defined hierarchical structure, e.g., Book Number, Chapters, Sections and Texts,

including at least on hierarchical tier, e.g., Book Number, *and at least one subordinate tier*, e.g., Chapter);

　　　　　presenting a plurality of selectable objects to a user, each object representing a subset of the collection of

content (The GUI of Slide 1 also indicates the step of *presenting a plurality of selectable objects to a user*,

e.g., "New! Text" and "New! Reading 1: The Shape of the American Ideology, Everett Carl

Ladd", *each object representing a subset of the collection of content* as in Pages 5-10);

　　　　　in response to selection by a user of one or more of said objects and assignment by said user of said

selected objects to corresponding ones of said at least one hierarchical tier and said at least one subordinate tier,

creating a custom content object including a hierarchical compilation of the content represented by each selected

object in accordance with said assignment of said selected objects by said user (*in response to selection by a user*

of one or more of chapters and sections as *objects* by using the add button via the GUI of Slide 1,

and *assignment by said user of said selected objects to corresponding ones of said at least one hierarchical tier*

and said at least one subordinate tier via the GUI of Slide 2, e.g., the selected object "Reading 2: The

Mischiefs of Faction, James Madison" is assigned under a Book Number 7908934 and a

Chapter "Patterson: We The People". The customized e-book that has book number 7908934

as *a custom content object* is created. The created customized e-book *includes a hierarchical compilation*

of the content represented by each selected object, Chapter "Patterson: We The People" and Section

"Constitutional Democracy". The Chapter "Patterson: We The People" and Section

"Constitutional Democracy" as *hierarchical compilation of the content* are *represented by each selected*

object, e.g., via the GUI of Slide 1, object "Reading 2: The Mischiefs of Faction, James Madison"

is selected, *in accordance with said assignment of said selected objects by said user*, e.g., the Chapters and

Section is in accordance with the assignment of the selecting of "Reading 2: The Mischiefs of

Faction, James Madison" to the Book Number 7908934 via the GUI of Slide 2);

storing said custom content object in said one or more object servers (As further discloses by

McGraw Hill, after creating the customized e-book, the e-book could be downloaded from

eBookstore. This technique implies the customized e-book as *the custom content object* is *stored in*

eBookstore as *one or more object servers*);

storing information specifying the custom content object and attribute information concerning the

custom content object (As show in Slide 2, *information specifying the custom content object*, e.g., Page

Count, and *attribute information concerning the custom content object*, e.g., Price, are stored in

accordance with the created e-book).

The missing of McGraw Hill is a *library server* for storing the information and attribute of

the e-book.

As disclosed by Santamaki at Col. 5, Lines 6-16, a centralized server for storing the

electronic written materials, and an e-book server for storing selected electronic written

materials that have been converted into an electronic book format to subsequent download to a

terminal for viewing.

Thus, the Santamaki teaching of centralized server as *library server*, obviously, could be

used for storing *information specifying the custom content object*, e.g., Page Count, and *attribute*

information concerning the custom content object, e.g., Price.

By using centralized server as *library server* for storing information and attributes, these

particular features of an e-book could be keep tracked and retrieved in accordance with the user

that creates the e-book.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to include a library server as taught by Santamaki in order to keep track and retrieve the information and attribute with respect to the created e-book.

Regarding claims 6, 36 and 66, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the collection of content comprises hierarchically related data* (page 7).

Regarding claims 7, 37 and 67, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 6, 36 and 66, McGraw-Hill further disclose *the collection of content comprises text documents and the subset of content associated with each selectable object comprises at least one of a section* (pages 3 and 7).

Regarding claims 8, 38 and 68, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *displaying to the user the selected objects in a predetermined order such that the user may rearrange the order of the selected objects as desired through a user interface* (Review and Resequence, page 9).

Regarding claims 11, 41 and 71, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses the step of *receiving content input by a user and creating a selectable object from the content* (pages 5-7).

Regarding claims 12, 42 and 72, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the user may concurrently create a plurality of content objects* (pages 7, 9 and 12).

Regarding claims 13, 43 and 73, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses the step *presenting the custom content object to a user for modification after creation of the compilation* (page Review and Resequence of page 9).

Regarding claims 14, 44 and 74, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 13, 43 and 73, McGraw-Hill further discloses the step of *creating a copy of the custom content object, applying changes input by a user to the copy, and creating a new custom content object therefrom* (page 3).

Regarding claims 15, 45 and 75, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 13, 43 and 73, McGraw-Hill further discloses *the user may select an object for removal from the custom content object* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding claims 16, 46 and 76, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the user may select to clear the custom content object* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding claims 17, 47 and 77, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill does not explicitly disclose *the user may select to undo an operation affecting the custom content object*. However, undo an operation that affecting a compilation is a conventional operation such as the undo in Word Editor. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by including the technique of undoing an object from a compilation in order to compile a document.

Regarding claims 18, 48 and 78, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses the claimed *submitting the custom content object to an approval process after creation of the compilation* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding claims 19, 49 and 79, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 18, 48 and 78, McGraw-Hill further discloses *the approval process further comprises approving the custom content object for publication* (Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding claims 20, 50 and 80, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill further discloses *the presenting step further comprises the step of presenting all of the content comprising the collection of content to the user as a plurality of selectable objects* (page 7).

Regarding claims 21, 51 and 81, McGraw-Hill/Warnock and Santamaki, in combination,

teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61,

McGraw-Hill further discloses *the presenting step further comprises the step of presenting less than all of the*

content comprising the collection of content to the user as a plurality of selectable objects (pages 5-7).

Regarding claims 22, 52 and 82, McGraw-Hill/Warnock and Santamaki, in combination,

teach all of the claimed subject matter as discussed above with respect to claims 21, 51 and 81,

McGraw-Hill further discloses the step of *partitioning the collection of content into a plurality of*

categories, and presenting all content objects belonging to a category to a user (page 5).

Regarding claims 23, 53 and 83, McGraw-Hill/Warnock and Santamaki, in combination,

teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61,

McGraw-Hill further discloses the step of *receiving search criteria input by the user; determining which of*

the subsets of the collection of content satisfy the search criteria; and presenting to the user a plurality of

selectable objects corresponding to the subsets of content satisfying the search criteria (pages 5-6).

Regarding claims 25, 55 and 85, McGraw-Hill/Warnock and Santamaki, in combination,

teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61,

McGraw-Hill further discloses *a selectable object further comprises one of a container and a content entity*

(page 7).

Regarding claims 26, 56 and 86, McGraw-Hill/Warnock and Santamaki, in combination,

teach all of the claimed subject matter as discussed above with respect to claims 25, 55 and 85,

McGraw-Hill further discloses *in response to selection of the container to add to a custom content object,*

adding the selected container and any containers or content entities it contains to the custom content object

(Microsoft Powerpoint presentation presenting how to user Primis Online).

Regarding claims 27, 57 and 87, McGraw-Hill/Warnock and Santamaki, in combination,

teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61,

McGraw-Hill further discloses *the selectable objects further comprise titles of their associated subsets of*

content (page 7).

Regarding claims 28, 58 and 88, McGraw-Hill/Warnock and Santamaki, in combination,

teach all of the claimed subject matter as discussed above with respect to claims 25, 55 and 85,

McGraw-Hill further discloses *containers are at least one of a book, a volume, and a chapter* (page 7).

Regarding claims 91, 94 and 97, McGraw-Hill/Warnock and Santamaki, in combination,

teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61,

McGraw-Hill further discloses *the compilation of content is created automatically in response to the user*

selecting said one or more of said objects (page 7).

Claims 3, 29, 33, 59, 63 and 89 are rejected under 35 U.S.C. 103(a) as being

unpatentable over The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing],

Santamaki et al. [USP 6,886,036 B1] in view of Mortimer et al. [USP 6,091,930].

Regarding claims 3, 33 and 63, McGraw-Hill/Warnock, Santamaki and Mortimer, in

combination, teach all of the claimed subject matter as discussed above with respect to claims

2, 32 and 62, McGraw-Hill further discloses *subsets of content comprise one of a chapter and sections of a text document* (McGraw-Hill, page 7).

Regarding claims 29, 59 and 89, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 25, 55 and 85, McGraw-Hill further discloses *the collection of content comprises at least one of a book* (McGraw-Hill, page 5). McGraw-Hill does not teach *the collection of content comprises at least one of image album and videos*. Mortimer teaches a technique of creating a customized student book and the collection of content comprises image album and a video (Mortimer, FIG. 2a). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by including image and video in the collection of content in order to construct an electronic book embedded with image and video.

Claims 4, 5, 34, 35, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing], Santamaki et al. [USP 6,886,036 B1] in view of ksinclair.com [Free E-books You Can Download].

Regarding claims 4, 34 and 64, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, but fails to disclose *each selectable object is associated with a cost, and further comprising the step of calculating a cost for the created custom content object based upon the costs of the selected objects*. Ksinclair.com has a website that presenting a plurality of e-books to a user and a user could open or download the e-book to the user site by selecting the title of an e-book. Ksinclair.com

further discloses *each selectable object is associated with a cost* but fails to disclose the step of

calculating a cost for the created custom content object based upon the costs of the selected objects. However, a

cost for a created compilation is a service charge based on the cost of maintaining an object

such as an e-book and could be calculated upon the cost of that e-book. Therefore, it would

have been obvious for one of ordinary skill in the art at the time the invention was made to

modify the McGraw-Hill method by applying the cost of an object from ksinclair.com method and

including the cost of created compilation based upon the cost of the object in order to maintain

the system.

Regarding claims 5, 35 and 65, McGraw-Hill/Warnock and Santamaki, in combination,

teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61,

McGraw-Hill further disclosed the step of *determining a content count for the custom content object*

(McGraw-Hill, page 7), but not the step of *determining a cost for the custom content object based upon the*

content count. Ksinclair.com has a website that presenting a plurality of e-books to a user and a

user could open or download the e-book to the user site by selecting the title of an e-book. The

downloadable ksinclair.com e-book has a cost associated with the e-book (ksinclair.com). Thus

the cost of the compilation for a particular chapter could be calculated based upon the content

count. Therefore, it would have been obvious for one of ordinary skill in the art at the time the

invention was made to modify the McGraw-Hill method by applying the cost of an object from

ksinclair.com method and including the cost of created compilation based upon the content

count in order to maintain the system.

Claims 9, 10, 24, 39, 40, 54, 69, 70, 84, 92, 93, 95, 96, 98 and 99 are rejected under

35 U.S.C. 103(a) as being unpatentable over by The McGraw-Hill Companies [McGraw Hill

Primis Custom Publishing], Santamaki et al. [USP 6,886,036 B1] in view of Poole et al.

[USP 6,006, 242].

Regarding claims 9, 39 and 69, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, but does not disclose the step of *defining a maximum amount of allowable content per volume of content; creating a plurality of volumes of content from the selected content based upon the defined maximum*. Poole teaches an apparatus and method for dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form (Poole, Col. 1, Lines 15-20). Poole further discloses the step of *defining a maximum amount of allowable content per volume of content; creating a plurality of volumes of content from the selected content based upon the defined maximum* (Poole, FIG. 17). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill technique by including the step of defining a maximum amount of content in order to compile an e-book online.

Regarding claims 10, 40 and 70, McGraw-Hill/Warnock, Santamaki and Poole, in combination, teach all of the claimed subject matter as discussed above with respect to claims 9, 39 and 69, Poole further discloses the step of *displaying to the user the selected objects contained in each volume such that the user may selectably move an object from a first to a second of the volumes* (Poole, Col. 11, lines 25-50).

Regarding claims 24, 54 and 84, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, but does not explicitly disclose *at least one of the subsets of content is associated with one or more*

prerequisite subsets of content and upon selection by the user of a selectable object associated with the at least one subset, also including the associated prerequisite subsets of content in the created custom content object. Poole teaches an apparatus and method for dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form (Poole, Col. 1, Lines 15-20). Poole further discloses *at least one of the subsets of content is associated with one or more prerequisite subsets of content and upon selection by the user of a selectable object associated with the at least one subset, also including the associated prerequisite subsets of content in the created custom content object* (Col. 7, Lines 1-6). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill technique to include the nested object in order to compile an e-book with embedded pictures or graphics.

Regarding claims 92, 95 and 98, McGraw-Hill/Warnock and Santamaki, in combination, teach all of the claimed subject matter as discussed above with respect to claims 1, 31 and 61, McGraw-Hill does not explicitly disclose *the compilation of content is created by recording in a computer-readable structure defining the compilation, for each selected object, a reference to the content entity associated with the selected object.* Poole teaches an apparatus and method for dynamically constructing an electronic document for subsequent publication in pre-printed or electronic form (Poole, Col. 1, Lines 15-20). Poole further discloses *the compilation of content is created by recording in a computer-readable structure defining the compilation, for each selected object, a reference to the content entity associated with the selected object* (FIG. 5). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill technique by referencing the content entities in order to compile an e-book.

Regarding claims 93, 96 and 99, McGraw-Hill/Warnock, Santamaki and Poole, in combination, teach all of the claimed subject matter as discussed above with respect to claims

92, 95 and 98, Poole further discloses *the computer-readable structure defining the compilation in a custom content outline (CCO) containing the references that correspond to the selected objects, and wherein said references are identifiers of the content entities associated with the selected objects* (FIG. 5).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HUNG Q PHAM
Examiner
Art Unit 2168

February 1, 2007